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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Re: Application No. 09/866,652;  
Art Unit: 3624; Examiner: Charles R. Kyle

October 2<sup>nd</sup> 2004

Dear Sir/Madam,

Enclosed please find the below described materials relating to the above identified application for U.S. Utility Patent in the name of Tommaso Innocenti of Prato, Italy:

- a. Letter of Transmittal & Certificate of Mailing on: 1 sheet; (this one)
- b. 'Brief in Support of Appeal - 37 CFR §1.192' in triplicate on: 72 sheets;
- c. Cheque in the amount of \$170 payable to 'Commissioner for Patents' in payment of the Filing Fee for a Brief in Support of Appeal under 37 CFR §41.20(b)(2).

Please file the above described materials in the above identified application for patent. Thank you kindly for your service.

Respectfully yours,

*Peter Gibson, Reg. #34,605*

Peter Gibson, Reg. #34,605

Tel. 410/358-5912; Fax -9636

**Certificate of Mailing**

I, Peter Gibson, Reg. #34,605, hereby certify with my dated signature below that the above described materials are being deposited with the U.S. Postal Service in an envelope bearing sufficient postage as First Class Mail addressed to 'Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450' today, October 2<sup>nd</sup> 2004.

*Peter Gibson, Reg. #34,605*

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Application No.: 09/866,652  
Filed: May 30<sup>th</sup> 2001

Art Unit: 3624

Examiner: Charles R Kyle  
Applicant: Tommaso Innocenti



**BRIEF IN SUPPORT OF APPEAL - 37 CFR §1.192**

**I. Real Party in Interest**

Appellant respectfully submits that the real party of interest is the same as the present inventor and applicant: Tommaso Innocenti, of Prato, Italy.

**II. Related Appeals and Interferences**

Appellant respectfully submits that no other appeals or interferences are known to appellant or appellant's legal representative which might directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**III. Status of Claims**

Appellant respectfully submits that: original claims 1 - 39 were canceled, i.e. replaced by pending claims 40 - 76 in a request for continued examination, and that the repeated rejection made final of all pending claims 40 - 76 is being appealed; or in the words of 37 CFR §1.192(c)(3): all pending claims 40 - 76 are appealed.

**IV. Status of Amendments**

Appellant respectfully submits that no amendment has been filed subsequent to the final rejection being appealed.

**V. Summary of Invention**

Appellant respectfully submits that the present invention is, in the words of sole base claim 40, a "business method intended to facilitate flexible terms commodities trading" comprised of seven basic steps including:

10/06/2004 BSAYASI1 00000049 09866652

01 FC:2402

170.00 OP

~~10/05/2004 BSAYASI1 00000028 09866652~~

~~01 FC:2401~~

~~470.00 OP~~

Adjustment date: 10/06/2004 BSAYASI1

~~10/05/2004 BSAYASI1 00000028 09866652~~

01 FC:2401

~~170.00 OP~~

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1. “providing, upon a web site ... a proposal format in which the type of auction can be specified in addition to ... specific commodity category dependent quality characteristics desired by a prospective buyer”, or “seller”, “in completion of a submission for initiating an open bid”, or “open offer”, respectively;
2. “providing the option of provision of a model”, or “sample”, “of a particular commodity desired for purposes of indicating the quality desired by a prospective buyer”, or “seller”, respectively;
3. “posting upon said web site a listing ... in accordance with a completed proposal submission ... comprising an open offer ... when initiated by a prospective seller and ... an open bid ... when initiated by a prospective buyer;”
4. “scheduling an auction of said specified lot by posting a plurality of schedule dates including ... commencement and conclusion dates”;
5. “posting upon said web site ... counter bids received in response to an open offer and counter offers received in response to an open bid which vary in any of the terms”;
6. “posting upon said web site ... any offer indications ... in response to posted counter bids and any bid indications ... in response to posted counter offers”;
7. “indicating upon said web site ... the matching in all said terms between any offer and any bid both concerned with said specified lot.”

**VI. Issues**

Appellant respectfully requests consideration of the below listed issues for which arguments containing the authorities relied upon in appeal follow in the order and under the issue heading indicated by the listing A - E below:

**BRIEF IN SUPPORT OF APPEAL - 37 CFR §1.192**

- A. Repetition of Rejection Made Final;
- B. Language Rejection Under 35 U.S.C. 112;
- C. Exclusion of Lerner from Prior Art;
- D. Failure of Rejection Under 35 U.S.C. 103;
- E. Absence of Base Claim Limitations in Prior Art.

**A. Repetition of Rejection Made Final**

1. Appellant respectfully submits that the final rejection conveyed in the fifth Office action dated May 4<sup>th</sup> 2004, and Applicant respectfully apologizes for the error in the heading and textual citation in response to the fourth Office action mis-identifying it as the fifth, comprises a verbatim repetition of the rejection made in the fourth Office action, that while 'Response to Arguments' on pages 9 - 13 was added, this additional section conveyed no rejection of any claim.

2. Appellant respectfully submits in evidence of verbatim repetition of rejection that the paragraph below, found in the middle of page 8 in either action, contains the same ungrammatical construction:

As to Claims 65-70, they are the buyer side of sample provision. See the discussion of Claims 71 and 72-76 below. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have for a buyer to provide a sample/model specifying the quality of commodities because this would have allowed the seller to know exactly the qualities desired.

pointed out by Applicant in response to the previous Office action:

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7. Applicant respectfully submits that the rejection of claims 65 - 70 under 35 U.S.C. 103(a) is in error because the attribution given for the motivation to combine references: "to have for (sic) a buyer to provide a sample/model specifying the quality of commodities *because this would have allowed the seller to know exactly the qualities desired.*" (5<sup>th</sup> OA., page 8, 4<sup>th</sup> par., last, emphasis added); is neither attributed to, nor found in, the prior art.

**B. Language Rejection Under 35 U.S.C. 112**

1. Appellant respectfully submits that Examiner's rejection under 35 U.S.C. 112: "These phrases do not make clear if a model or sample are ever provided and are read as not being limitations"; consists of a capricious decision based on an irrelevant and impossible requirement: dictating the behavior of participants; supported by erroneous allegations, irrelevant criticisms, and repetition of the same impossible expectation:

Additionally, the optional provision does not relate to the rest of the claim language. No use of the quality indications is made in the execution of the auction. An inventive feature such as bid calculation based on indicated quality would perhaps relate these limitations to the rest of the Claim.

Claims 53, 54, 57, 59, 60 and 63 recite the qualifier 'may choose', which is unclear as to whether a choice is made. (Page 2, 4<sup>th</sup> & 5<sup>th</sup> action);

because:

- a. the method claimed can only provide, to any prospective seller or buyer, the option of providing a sample or model when initiating an open offer or bid, it can not dictate participant behavior; just as
- b. it is not possible to dictate that a 'choice be made', only to provide the choice; and

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- 1 c. 'quality indications' are certainly used in the method claimed, "providing the option  
2 of provision of a model of a particular commodity desired" is, specifically, "for  
3 purposes of indicating the quality desired by a prospective buyer" as is provision of  
4 a sample for "indicating the quality (offered) by a prospective seller"; while  
5 d. 'the rest of the claim language' includes specification of: "specific commodity  
6 category dependent quality characteristics" required in the posting of a listing of a lot  
7 "in accordance with a completed proposal submission detailing a plurality of terms  
8 including weight, price, quality characteristics, delivery and payment"; and  
9 e. 'an inventive feature such as bid calculation based on indicated quality' describes the  
10 essential decision process of auction participants facilitated by including 'quality  
11 characteristics' in the listing and claiming the same would deny an auction.

12  
13 2. Appellant respectfully submits that the present claims clearly point out and distinctly  
14 claim the invention, that no indefinite language in the claims has been identified in  
15 examination, and the only impediment with regard to satisfaction of the requirements of 35  
16 U.S.C. §112 evident in this examination is the failure of the Examiner to understand either  
17 said requirements or the operation of an auction generally wherein participants, while  
18 confined by procedural rules, are otherwise free to choose as they please because:

19  
20 If the claims, read with the specification, reasonably apprise those skilled in  
21 the art of both the utilization and the scope of the invention, and if the  
22 language is as precise as the subject matter permits, the courts can demand no  
23 more.<sup>237</sup> (Robert L. Harmon, *Patents and the Federal Circuit*, BNA Books,  
24 Washington, D.C., Sixth Ed., 2003, pp. 260-261; citing: *Miles Labs., Inc. v.*  
25 *Shandon, Inc.*, 997 F.2d 870, 27 USPQ2d 1123 (Fed. Cir. 1993); *Hybritech*  
26 *Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (Fed. Cir.

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1 1986); *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613,  
2 225 USPQ 634 (Fed. Cir. 1985)).  
3  
4

5 3. Appellant respectfully submits that Examiner's 'Response to Arguments' "regarding  
6 rejections under 35 U.S.C. 112":  
7

8 Applicant fails clearly (to) explain a relationship between the claim language  
9 and the passages cited from the prior office action. Applicant fails to address  
10 the Examiner's observation that '*No use of the quality indications is made in*  
11 *the execution of the auction. An inventive feature such as bid calculation*  
12 *based on indicated quality would perhaps relate these limitations to the rest*  
13 *of the Claim.*' Applicant fails to discuss his citation of the Examiner's  
14 phrasing to explain why his phrasing is clear.

15 At pages 14 and 15, Applicant argues the first 112 cause for rejection,  
16 Applicant's phrasing of 'providing an option of provision ...' in the Claims  
17 rejected under 35 U.S.C. 112, 2<sup>nd</sup> para. can also be interpreted as merely  
18 providing an interface button (option) usable to order a sample or model.  
19 Applicant's phrasing is vague as to what is actually provided. Reasonable  
20 consideration can be given to meanings in the specification, but the wording  
21 is so vague as to be ambiguous.

22 As to Applicant's arguments regarding the rejection over 'may choose'  
23 phrasing, in each recitation of Claim language at pages 16-17, the wording is  
24 vague. In each instance, a seller or buyer has an option of choosing certain  
25 parameters, but is not required to do so by the Claim limitations. If the buyer  
26 or seller exercises the option to not choose any parameters, the Claim language  
27 is irrelevant and not further limiting. (Pages 9 - 10);  
28

29 relies upon the same logic utilized in rejection in the previous two Office actions, rebutted  
30 above, with the additional assertion that 'the wording is so vague as to be ambiguous' bereft  
31 of any support save the repeated complaints that:

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- 1 a. 'No use of the quality indications is made',
- 2 b. 'Applicant fails to discuss his citation of the Examiner's phrasing', and
- 3 c. 'a seller or buyer has an option ... but is not required to do so by the Claim';
- 4 with no reason given for why the language is vague or ambiguous except: 'Applicant's
- 5 phrasing is vague as to what is actually provided'; referencing 'providing an option of
- 6 provision', possibly indefinite because of the 'an', but the phrases actually recite "providing
- 7 the option of provision of a model (or sample) of a particular commodity": options fully
- 8 explained in the specification eliminating ambiguity; while Examiner's last supporting plaint:
- 9 d. 'If the buyer or seller exercises the option to not choose any parameters, the Claim
- 10 language is irrelevant and not further limiting';
- 11 is clearly erroneous as the limitations are necessarily: (i) providing the option of provision
- 12 of a sample to prospective sellers, and (ii) providing the option of provision of a model to
- 13 prospective buyers; and it is irrelevant 'if the buyer or seller exercises the option' because
- 14 the options still exist and provision of the options are necessary to the claimed invention.
- 15
- 16 4. Appellant respectfully submits that:
- 17 a. 'providing an option of provision' of a sample or a model by a prospective seller or
- 18 buyer, "for purposes of indicating the quality desired" comprises the best means of
- 19 indicating quality augmenting the 'use of the quality indications';
- 20 b. failure to discuss 'citation of the Examiner's phrasing' is wholly irrelevant because
- 21 Examiner's phrasing is not at issue here;
- 22 c. the language of the claims can not require a buyer or seller to exercise an option, said
- 23 language can only define the option provided;



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1 d. the claim language is limiting in necessarily providing the options; and  
2 hence the repeated complaints supporting Examiner's allegation of language 'so vague as to  
3 be ambiguous' are respectively: erroneous, irrelevant, impossible, and erroneous.  
4

5 5. Appellant respectfully submits that the present base claim does contain two hitherto  
6 unnoticed and wholly accidental informalities of language: the word 'desired' in line 13 is  
7 extraneous and in line 14 would be better replaced by a word such as 'offered' which  
8 correction:

9 c. Providing the option of a provision of a sample of a particular commodity  
10 [desired] for purposes of indicating the quality [desired] offered by a prospective  
11 seller; in lines 13 and 14

12 would better define the step of providing the option of provision of a sample by a prospective  
13 seller in contrast to the language used in the step of providing the option of provision of a  
14 model by a prospective buyer, lines 7 - 8, and is invited by Examiner's amendment in  
15 correction of the only language informalities known in the present claims.  
16

17 **C. Exclusion of Lerner from Prior Art**

18 1. Appellant respectfully submits that Examiner was in error in rejecting the declaration  
19 dated January 20, 2004 attesting to the receipt of Exhibit A by the present patent practitioner  
20 on 15 June 2000 and to consider this evidence 'insufficient' to disqualify Lerner from valid  
21 prior art as being predated by the invention and exercise of due diligence because:

22 a. Exhibit A is dated: the transmitting facsimile machine clearly dated it in the top  
23 margin 15/06/00, 15 June 2000;

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- 1     b.     Exhibit A doesn't require a signature;  
2     c.     due diligence is provided in the exhibit in the form of a request for assistance in  
3           obtaining U.S. Patent Protection for his invention:

4  
5           I have devised a special, new way to put up natural raw  
6           materials auctions for internet auctions and I would like to  
7           implement it but, before any further step, I would like to patent  
8           it in order to prevent competitions' imitation ... (is it) sufficient  
9           to list ... all the software program instructions or, even easier ...  
10          the algorithmic and logic operations of what the web site server  
11          uses and then drawing it through a flow chart ... if your office  
12          can help me into the all process even if I live in Italy ... Your  
13          sincerely, Dr. Tommaso Innocenti (Exhibit A);  
14

- 15          as this initial contact resulted in the present application being filed;  
16     d.     the inventor was clearly, as demonstrated by Exhibit A, in possession of the invention  
17           at the time of the machine dated transmission received on 15 June 2000 as declared  
18           by the present practitioner;  
19     e.     15 June 2000 is prior to the effective, claimed provisional, filing date of Lerner.  
20

21     **D.     Failure of Rejection Under 35 U.S.C. 103**

- 22     1.     Appellant respectfully submits that Examiner was in error to rely upon benefits  
23           provided by the presently claimed invention in rejection:

24  
25           As to Claims 65-70, they are the buyer side of sample provision. See  
26           the discussion of Claims 71 and 72-76 below. It would have been obvious to  
27           one of ordinary skill in the art at the time the invention was made to have for  
28           a buyer to provide a sample/model specifying the quality of commodities

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1 because this would have allowed the seller to know exactly the qualities  
2 desired. (Page 8);  
3

4 as allowing ‘the seller to know exactly the qualities desired’ is precisely the intention of  
5 providing the option of providing a model: “for purposes of indicating the quality desired by  
6 a prospective buyer” (lines 7 - 8); given in present base claim 40 and while knowledge  
7 generally available to one practiced in the art may be relied upon in rejection under 35  
8 U.S.C. 103 hindsight of the applicant’s disclosure can not be so relied upon:

9  
10 §103 demands that obviousness be tested as of ‘the time the invention was  
11 made.’<sup>31</sup> The analytic focus is upon the state of knowledge at the time the  
12 invention was made.<sup>32</sup> ... The judge now knows all about the invention; he or  
13 she must determine whether it would have been obvious to those who knew  
14 only about the prior art.<sup>34</sup> He or she must view the prior art without reading  
15 into it the (application’s) teachings.<sup>35</sup> (Robert L. Harmon, *Patents and the*  
16 *Federal Circuit*, BNA Books, Washington, D.C., Sixth Ed., 2003, p. 157;  
17 citing: <sup>31</sup>35 U.S.C. §103; <sup>32</sup>*In re Raynes*, 7 F.3d 1037, 28 USPQ2d 1630 (Fed.  
18 Cir. 1990); <sup>34</sup>*Panduit Corporation v. Dennison Mfg. Co.*, 774 F.2d 1082, 227  
19 USPQ 337 (Fed. Cir. 1985));  
20

21 And although the person skilled in the art is presumed to know the art--indeed,  
22 he or she is pictured as working in a shop with the art hanging on the walls  
23 round about--the art in question is only that which he or she would have  
24 selected without the advantage of hindsight or knowledge of the invention.<sup>37</sup>  
25 (*Ibid.*, p. 158; citing <sup>37</sup>*Union Carbide Corp. v. American Can Co.*, 724 F.2d  
26 1567, 220 USPQ 584 (Fed. Cir. 1984);  
27

28 Hindsight is a tempting but forbidden zone.<sup>43</sup> (*Ibid.*, p. 158; citing <sup>43</sup>*Loctite*  
29 *Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 228 USPQ 90 (Fed. Cir. 1985)); and  
30  
31

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1 in lacking any attribution to the prior art and relying solely upon motivation to modify prior  
2 art reflecting a benefit of the presently considered invention hindsight of the invention  
3 remains as the only possible source for both the elements added in modification as well as  
4 the only source for the motivation for the modification.  
5

6 2. Appellant respectfully submits that use of hindsight of the invention being considered  
7 in examination is prohibited and safe guarded against by the requirement that: "Both the  
8 suggestion and the expectation of success must be founded in the prior art, not in the  
9 applicant's disclosure."<sup>339</sup> (*Ibid.*, p. 200; citing <sup>337</sup>*Panduit Corp. v. Dennison Mfg. Co.*, 810  
10 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987)); and any rejection under 35 U.S.C. 103 lacking  
11 either the suggestion or expectation of success in the prior art, and both are lacking in the  
12 present case, is improper and defective.  
13

14 3. Appellant respectfully submits that the discussion immediately above is fully  
15 applicable to the only rejection under 35 U.S.C. 103 of the sole base claim 40 because said  
16 base claim requires providing the option of provision of a model by a prospective buyer and  
17 there is no prior art identified by examiner as disclosing or suggesting the provision of a  
18 model, only the 'converse' provision of a sample, by flying 'a team' to 'potential vendor  
19 sites' or 'production facilities' to personally visit and 'obtain samples':  
20

21 In many corporations, the election of a new supplier for production  
22 purchases usually involves the creation of a team from purchasing,  
23 engineering, and manufacturing to evaluate all potential sellers. *The team*  
24 *usually flies to potential vendor sites to evaluate capabilities and production*  
25 *facilities, obtain samples, and then return home to evaluate the samples.*

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1 (Conkling, column 8, lines 17 - 24, emphasis added);  
2

3 which common practice could not possibly disclose or suggest “providing the option of  
4 provision of a sample of a particular commodity” “upon a web site” as required by present  
5 base claim 40 much less possibly disclose or suggest “providing the option of provision of  
6 a model of a particular commodity” “upon a web site” as additionally required by present  
7 base claim 40 and hence there is absolutely no possibility of ‘founding’ either the suggestion  
8 or the expectation of success in the prior art as required of any rejection under 35 U.S.C.  
9 103.  
10

11 4. Appellant respectfully submits that the rejection of claims 40 - 64 under 35 U.S.C.  
12 103, repeated and made final in the last Office action, was thoroughly rebutted, regardless  
13 of prior art inclusion or exclusion of *Lerner*, in response to the previous Office action and  
14 this rebuttal was only addressed in the last Office action in the one following paragraph:  
15

16 As to the 35 U.S.C. rejections, at section B, para. 2, (Applicant) appears  
17 to argue that *Lerner*, by not disclosing auction format specification, is  
18 precluded from disclosing an auction. The Examiner cited *Lerner* at paras.  
19 117 and 121 as disclosing an auction which inherently has steps a. and b. at  
20 lines 14-17 of page 9 of the response. (p. 10, 3<sup>rd</sup> par.);  
21

22 regarding section B, Errors in Examination, while the only response to section C, Submission  
23 of Evidence Overcoming Grounds of Rejection, at the bottom of page 12 is concerned with  
24 Applicant’s attempt “to disqualify the *Lerner* reference” and “As to other paras. In Section  
25 (C), they are restatements of points addressed above”.  
26

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1     5.     Appellant respectfully submits, in demonstration of the failure of the last Office action  
2     to address the rebuttal of the rejection of claims 40 - 64 except for the one paragraph recited  
3     above, that the 'Response to Arguments' therein, after beginning with the blanket statement  
4     that "Applicant's arguments filed February 6, 2004 have been fully considered but they are  
5     not persuasive" (page 9) and ending in "Arguments presented by Applicant at other locations  
6     of the response are repetitive and addressed above" (page 13) consists of:

- 7     a.     referral to MPEP for change of correspondence address;  
8     b.     acknowledgment of section A, Acknowledgment of Action, with a sentence: "At  
9     pages 1-8 of the Response, Applicant exhaustively discusses elements of the prior  
10     office action.";  
11    c.     response to arguments concerning rejection under 35 U.S.C. 112 on pages 9 - 10;  
12    d.     the paragraph recited above;  
13    e.     erroneous accusation of irrelevant failure in argument:

14  
15                 At para. 3, Applicant fails to explain why the features disclosed  
16                 by *Moshal* and providing motivation in combine (sic) are not  
17                 beneficial. *Applicant* quotes *Moshal* as disclosing configurability,  
18                 flexibility and high capacity. Applicant fails to explain why these are  
19                 not beneficial and why they would not provide a reason for the  
20                 combination of references.  
21

22                 as Applicant actually pointed out that the "motivation attributed to the prior art ... is  
23                 lacking" because *Moshal* "fails to specify any particular benefits, only 'multiple  
24                 existing new types of auction' that 'may be created and conducted'" which can only  
25                 be regarded as speculation in terms so general as to be suggestive of anything and  
26                 hence nothing in particular;

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- 1 f. repetition of an irrelevant, illogical, and wholly extraneous argument: "At para. 4,  
2 Applicant appears to suggest that different buyer and seller web sites provide some  
3 feature or advantage ... In this case, different sites increase the number of access  
4 points to the system and enhance accessibility" (pages 10 - 11); despite the fact that  
5 the presently claimed invention specifies "a web site accessible upon the world wide  
6 web" (claim 40, line 3), use of multiple sites for hosting is not even mentioned in the  
7 entire application, and the idea was rebutted with the argument that this "makes no  
8 sense: use of different web sites does not improve Internet accessibility";
- 9 g. omission of paragraph B.5 in response unless the repetition of the blanket statement:  
10 "Applicant's arguments are fully addressed considering all grounds of rejection" is  
11 an argument in response;
- 12 h. an erroneous statement combined with an irrelevant accusation:
- 13 i. "At para. 6, Applicant admits that provision of a sample is 'common  
14 commerce practice'; and
- 15 ii. Applicant "fails to address why the Examiner's argument that such samples  
16 would help buyers evaluate potential sellers is incorrect";
- 17 as Applicant submitted that the rejection was "in error because Examiner admits that  
18 *Lerner and Moshal et al. 'do not disclose direct provision of a sample by a seller to*  
19 *a prospective buyer'*" (B. 6, p. 11) as the prior art cited as disclosing this, Conklin,  
20 just references a common commerce practice wherein "the team usually flies to  
21 potential vendor sites to evaluate capabilities and production facilities, obtain  
22 samples, and then return home to evaluate the samples"; which practice fails to  
23 disclose or suggest: direct provision of a sample, 'a particular commodity', direct

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1 provision of a sample to indicate the quality of a particular commodity, models of  
2 commodity quality desired, or use of any of these elements in an online auction.

3 i. in response to B.7 repetition of the statement, first made re. par. 4, that:

4  
5 obviousness can only be established by combining or modifying the  
6 teachings of the prior art to produce the claimed invention where there  
7 is come teaching, suggestion, or motivation to do so found either in the  
8 references themselves *or in the knowledge generally available to one*  
9 *of ordinary skill in the art*  
10

11 citing *In re Fine* and *In re Jones* without any actual argument pertaining to any issue  
12 at all;

13 j. in response to B.8, verbatim repetition of the above citing *In re Fine* and *In re Jones*  
14 without any actual argument pertaining to any issue at all;

15 k. in response to B.9, verbatim repetition of the above citing *In re Fine* and *In re Jones*  
16 without any actual argument pertaining to any issue at all;

17 l. in response to B.10, verbatim repetition of the above citing *In re Fine* and *In re Jones*  
18 without any actual argument pertaining to any issue at all;

19 m. no response whatsoever to paragraph C.5, recited in full below as one of the most  
20 important arguments presented by Applicant in rebuttal of the rejection of present  
21 base claim 40:

22 5. Applicant respectfully submits that regardless of the fact  
23 established by the declaration of prior invention under 37 CFR §1.131  
24 that *Lerner* is not prior art a number of limitations to the present base  
25 claim, 40, from which all other present claims are properly dependent,  
26 are undisclosed by the combination of *Lerner* and *Moshal et al.* relied  
27 solely upon in rejection of said base claim including:



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- 1 a. providing, upon a web site ... a proposal format *in which the*  
2 *type of auction can be specified* in addition to the particular  
3 commodity, weight, price, and specific commodity category  
4 dependent quality characteristics desired by a prospective buyer  
5 *in completion of a submission for initiating an open bid;*  
6 b. *providing the option of provision of a model* of a particular  
7 commodity desired for purposes of indicating the quality desired  
8 by a prospective buyer;  
9 c. providing, upon a web site accessible upon the world wide web,  
10 a proposal format *in which the type of auction can be specified*  
11 in addition to the particular commodity, weight, price, and  
12 specific commodity dependent quality characteristics offered by  
13 a prospective seller *in completion of a submission for initiating*  
14 *an open offer;*  
15 d. *providing the option of provision of a sample* of a particular  
16 commodity desired for purposes of indicating the quality desired  
17 by a prospective seller;

18 by Examiner's own admission: "Lerner does not specifically disclose  
19 auction format specification" (5<sup>th</sup> OA, page 5, 3<sup>rd</sup> par., first sentence)  
20 hence denying the steps of specifying the type of auction in a proposal  
21 format in completion of a submission initiating either an open bid or  
22 offer as the motivation for combining the teachings of *Moshal et al.*  
23 consists of prior art speculation of "multiple existing and new types of  
24 auction' that 'may be created and conducted'" (above, paragraph B.3);  
25 and "*Lerner and Moshal et al. 'do not disclose provision of a sample*  
26 *by a seller to a prospective buyer*" (above, paragraph B. 6) and  
27 therefore cannot disclose the step of providing the option of provision  
28 of a sample or model. (Pages 18 - 19);  
29

- 30 n. no response whatsoever to paragraph C.6 or C.7 recited in full below as one of the  
31 most important arguments presented by Applicant in rebuttal of the rejection of claim  
32 40:  
33

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Applicant respectfully submits that the language of the four steps in present base claim 40 identified above, and of other steps thereto, patentably distinguish the presently claimed invention over the prior art by offering an online auction format for commodities that allows prospective sellers and buyers to specify the type of auction “in addition to the particular commodity, weight, price, and specific commodity category dependent quality characteristics desired” in a submission initiating either an open offer or bid, according to the originator, and provides for the option of providing either a sample or model representative of the quality offered or sought, respectively, by a prospective seller or buyer. (Page 19)

o. the argument concerning inclusion of *Lerner* in the prior art discussed above in section C.1;

wherein it is seen that the main arguments presented by Applicant in rebuttal of repeated rejection of the present base claim concerning limitations in said base claim absent from and unsuggested by the prior art are wholly evaded except for the one paragraph recited in D.1 above.

6. Appellant respectfully submits that the sole paragraph addressing Applicant’s argument that the rejection of present base claim 40 is overcome by the demonstration that limitations therein are absent and unsuggested by the prior art:

As to the 35 U.S.C. rejections, at section B, para. 2, (Applicant) appears to argue that *Lerner*, by not disclosing auction format specification, is precluded from disclosing an auction. The Examiner cited *Lerner* at paras. 117 and 121 as disclosing an auction which inherently has steps a. and b. at lines 14-17 of page 9 of the response. (p. 10, 3<sup>rd</sup> par.);

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comprises a disingenuous misinterpretation of Applicant's argument that without auction format specification it was impossible to complete a submission of either an open bid or offer:

2. Applicant respectfully submits that the rejection of present base claim 40, and claims: 41, 43, 46 - 49, 52 - 54, 59-60, 62 and 63 under 35 U.S.C. 35 103(a), is in error by Examiner's own admission that: "*Lerner does not specifically disclose auction format specification.*" (5<sup>th</sup> OA, page 5, 3<sup>rd</sup> par. , first sentence, emphasis added); without which it is not possible for:

- a. "completion of a submission for initiating an open bid" (FOA, page 3, 4<sup>th</sup> par.; or
  - b. "completion of a submission for initiating an open offer" (FOA, pages 3 - 4);
- the first and third steps, respectively, of the presently claimed invention attributed to disclosure by *Lerner*. (Page 9);

and never intimated the absurd allegation that Lerner could not disclose an auction.

7. Appellant respectfully submits that the language of claim 40 restricts the presently claimed invention to:

- a. "providing, upon a web site ... a proposal format in which the type of auction can be specified ... by a prospective buyer in completion of a submission for initiating an open bid" (lines 3 - 6);
- b. "providing, upon a web site ... a proposal format in which the type of auction can be specified ... by a prospective seller in completion of a submission for initiating an open offer" (lines 9 - 12); which

limitations are both absent from and unsuggested by the only references cited by Examiner

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1 as supplying these steps as evidenced by Examiner's admission that "*Lerner does not*  
2 *specifically disclose the limitation of auction format specification.*" (p. 5, 1<sup>st</sup> sentence) and  
3 the fact that Mosal 'fails to specify any particular benefits', just speculation upon 'multiple  
4 existing new types of auction' that 'may be created or conducted'.  
5

6 8. Appellant respectfully submits that: since Examiner's only address of Applicant's  
7 contention that the step of providing 'a proposal format in which the type of auction can be  
8 specified' relies upon implicit disclosure by the very reference admitted to not disclose this  
9 limitation; rejection of present base claim 40 under 35 U.S.C. 103 is overcome because an  
10 unexplained allegation of inherence, particularly in a reference previously admitted not to  
11 disclose the limitation, is of no weight because "To establish inherency, the extrinsic  
12 evidence 'must make clear that the missing descriptive matter is necessarily present in the  
13 thing described in the reference, and that it would be so recognized by persons of ordinary  
14 skill.'" (MPEP 2112, citing: *In re Robinson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51).  
15

16 9. Appellant respectfully submits that:

- 17 a. 'at least some degree of predictability is required' (MPEP 2143.02) of the prior art  
18 in support of an obviousness rejection;  
19 b. Applicant may introduce evidence "showing there was no reasonable expectation of  
20 success" to "support a conclusion of nonobviousness" (*Ibid.*, citing *In re Rhinehart*,  
21 531 F.2d 1048, 189 USPQ 143 (CCPA 1976));  
22 c. absent the disclosure or suggestion by the prior art of all claimed limitations there can  
23 be no reasonable expectation of success; and

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1 hence demonstration that any claimed limitation is neither disclosed in, nor suggested by, the  
2 prior art comprises evidence of 'nonobviousness'.  
3

4 **E. Absence of Base Claim Limitations from Prior Art**

5 1. Appellant respectfully submits that the present base claim limitations of:

- 6 a. "providing, upon a web site ... a proposal format in which the type of auction can be  
7 specified" ( lines 3 - 4 & 9 - 10);  
8 b. "providing the option of provision of a model of a particular commodity desired for  
9 purposes of indicating the quality desired by a prospective buyer" (lines 7 - 8);  
10 c. "providing the option of provision of a sample of a particular commodity" "for  
11 purposes of indicating the quality (offered) by a prospective seller" (lines 13 - 14);  
12 d. "providing, upon a web site ... a proposal format in which ... commodity category  
13 dependent quality characteristics" "can be specified" (lines 3 - 5);  
14 e. "posting upon said web site, in association with said listing, any offer indications ...  
15 in response to posted counter bids and any bid indications ... in response to posted  
16 counter offers" (page 2, lines 4 - 6);

17 are each absent from and unsuggested by the prior art cited in rejection and recognition of  
18 the absence of any of these claimed limitations overcomes rejection of all the present claims  
19 under 35 U.S.C. 103 as any rejection thereunder must include all the claimed limitations:  
20

21 To establish *prima facie* obviousness of a claimed invention, all the claim  
22 limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d  
23 981, 180 USPQ 580 (CCPA). 'All words in a claim must be considered in  
24 judging the patentability of that claim against the prior art.' *In re Wilson*, 424  
25 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim

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1 is nonobvious under 35 U.S.C. 103, then any claim depending therefrom  
2 is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).  
3 (MPEP 2143.03).  
4

5  
6 2. Appellant respectfully submits that the provision of ‘a model of a particular  
7 commodity desired for purposes of indicating the quality desired by a prospective buyer’, in  
8 an online auction particularly, is most certainly neither disclosed nor suggested by the prior  
9 art as a sample taken away from a ‘potential vendor’ visited by a team neither discloses nor  
10 suggests:

- 11 a. a sample of ‘a particular commodity’;  
12 b. use of the Internet;  
13 c. an auction; or  
14 d. a model of something desired;

15 much less ‘a model of a particular commodity desired ... by a prospective buyer’ in an online  
16 auction and that this particular limitation, introduced to the present base claim by amendment  
17 in requesting continued examination, originally was in a dependent claim that was not even  
18 rejected initially and the only argument presented for disclosure or suggestion by the prior  
19 art relies on the equivalence of a sample and a model, which equivalence denies the  
20 distinction between prospective buyer and seller fundamental to any auction.  
21

22 3. Appellant respectfully submits that “In the ordinary patent case, the trier of fact must  
23 answer the *Graham* inquiries relating to (1) the scope and content of the prior art, (2) the  
24 differences between the art and the claims at issue, (3) the level of ordinary skill in the art,

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1 and (4) whatever objective evidence may be present.<sup>20</sup> (Robert L. Harmon, *Patents and the*  
2 *Federal Circuit*, BNA Books, Washington, D.C., Sixth Ed., 2003, p. 156; citing: <sup>20</sup>*Speciality*  
3 *Composites v. Cabot Corp.*, 845 F.2d 981, 6 USPQ2d 1601 (Fed Cir. 1988); *Allen Archery,*  
4 *Inc. v. Browning Mfg. Co.*, 819 F.2d 1087, 2 USPQ2d 1490 (Fed. Cir. 1987); *Connell v.*  
5 *Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).  
6

7 4. Appellant respectfully submits that both the scope and content of the prior art have  
8 been and continue to be disputed in the present examination, particularly regarding inclusion  
9 or exclusion of the *Lerner* reference, but that regardless of this issue: the scope of the prior  
10 art; factual determination of the content of the prior art necessarily excludes the provision  
11 of the option of providing a model of a particular commodity desired by a prospective buyer  
12 in an online auction as this limitation to present base claim 40 is unknown to the prior art as  
13 demonstrated by reliance upon alleged equivalence of a model with a sample, despite the  
14 necessary elimination of the fundamental difference between a prospective buyer and a seller  
15 necessary to any auction, leaving the claimed limitation without even an attribution to the  
16 prior art.  
17

18 5. Appellant respectfully submits that, regardless of other claimed limitations identified  
19 above (E.1) as being 'each absent from and unsuggested by the prior art cited in rejection',  
20 the absence of the option of providing a model of a particular commodity desired by a  
21 prospective buyer in an online auction from the content of the prior art constitutes a  
22 'difference between the art and the claims at issue' that 'the level of ordinary skill in the art'  
23 can not supply and hence, in accordance with *Graham v. Deere*, the presently claimed

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1 invention and all pending claims are unobvious in view of the prior art and patentably  
2 distinguished over the prior art by this novel limitation.

3  
4 6. Appellant respectfully submits that the content of the prior art, taken as a whole, has  
5 further been demonstrated to lack disclosure or suggestion of an online auction adapted for  
6 commodities wherein "specific commodity category dependent quality characteristics desired  
7 by a prospective buyer in completion of a submission for initiating an open bid" "can be  
8 specified" (lines 4 - 6) constitutes a 'difference between the art and the claims at issue' that  
9 'the level of ordinary skill in the art' can not supply and hence, in accordance with *Graham*  
10 *v. Deere*, the presently claimed invention and all pending claims are unobvious in view of  
11 the prior art and patentably distinguished over the prior art by this novel limitation.

12  
13 7. Appellant respectfully submits that the present brief has been timely filed in triplicate,  
14 all grounds of rejection made final have been overcome by factual evidence, a number of  
15 claimed limitations patentably distinguishing the presently claimed invention over the prior  
16 art including: specification of auction format, posting of offer indications in response to  
17 posted counter bids and bid indications in response to posted counter offers, specification  
18 of specific commodity category dependent quality characteristics either offered by a  
19 prospective seller, or most particularly desired by a prospective buyer, and the option of  
20 providing either a sample or, most particularly, a model "of a particular commodity desired  
21 for purposes of indicating the quality desired"; each have been pointed out, using the  
22 language of the claims, as limitations patentably distinguishing the presently claimed  
23 invention over the prior art.



Application No.: 09/866,652  
Filed: May 30<sup>th</sup> 2001

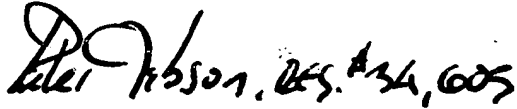
Art Unit: 3624

Examiner: Charles R Kyle  
Applicant: Tommaso Innocenti

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1     8.     Appellant respectfully submits, for all the reasons given above, that the present  
2     application is in full and proper condition for allowance which action is further respectfully  
3     requested preferably with the examiner's amendment invited above in correction of the only  
4     known language informalities in the claims.

5  
6     Respectfully yours,

7       
8

9     Peter Gibson, Reg. #34,605

10    Ph.410/358-5912; Fax-9636